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10/599,556	10/02/2006	Tsuyoshi Ueno	41413	1800
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PEARNE & GORDON LLP			EXAMINER	
1801 EAST 9TH STREET			MAI, KEVIN S	
SUITE 1200				
CLEVELAND, OH 44114-3108			ART UNIT	PAPER NUMBER
			4121	
			NOTIFICATION DATE	DELIVERY MODE
			11/14/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/599,556	UENO, TSUYOSHI
Examiner	Art Unit	
Kevin S. Mai	4121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 02 October 2006.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1 - 16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1 - 16 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 02 October 2006 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/02/2006.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

1. Claims 1 – 16 have been examined and are pending.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

3. The disclosure is objected to because of the following informalities:

Paragraph [0025] states “The information exchange support apparatus of the invention contains an apparatus, wherein the exchange request information contains preliminary disclosure and consent required/not required information indicating whether or not exchange consent is required, of information to be exchanged of the exchanging party, and wherein, if the consent required/not required information indicates required, the preliminary disclosure means preliminarily discloses the information to be exchanged for the exchanging party.” It appears to be a mistake because it explains that if the consent required/not required is required then the information will be disclosed. It seems it should be the other way around and would only freely disclose the information if consent was not required and it would wait until consent was received if consent was marked required. For the rest of the application it will be assumed that it was meant to read “... if consent required/not required information

indicates not required ...”

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 15 claims only a program for causing a computer to function, programs alone are considered non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 – 7, 10, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pub. No. 2003/0120616 to Sueki et al. (hereinafter “Sueki”).

**As to claim 1, Sueki teaches an information exchange support apparatus for supporting exchange of information through a network (Paragraph [0010] of Sueki discloses an invention to provide an information mediation system which is capable of**

mediating exchange of information between an applicant and registrant), the **information exchange support apparatus comprising:**

**a reception unit which receives exchange request information containing information to be exchanged and information for identifying an exchanging party** (Paragraph [0012] of Sueki discloses receiving a request of information exchange from an applicant and then receiving from the applicant information of a selected registrant);

**an exchange determination unit which determines whether or not information exchange is permitted using the received exchange request information** (Paragraph [0030] of Sueki discloses that the mediation server will choose possible registrants based on the application information. This is read to cover the functionality of the applicants invention because whether or not a registrant is eligible (permitted) to exchange information is determined by the application information (received exchange information)); and

**a transmission unit which transmits the information to be exchanged to the exchanging party if the exchange determination unit determines that information exchange is permitted** (Paragraph [0012] of Sueki discloses transmitting at least a part of the retrieved information of at least one of the registrant to the applicant and then in paragraph [0031] the mediation server sends the application information to the selected registrant),

**wherein, if the exchange request information from the mutual exchanging parties is already received, the exchange determination unit determines that information exchange is permitted** (Paragraphs [0031] - [0034] of Sueki disclose that after receiving the name of the selected candidate registrant from the applicant and after the registrant gives an affirmative response the mediation server notifies both parties to prepare for information exchange).

**As to claim 2, Sueki teaches the information exchange support apparatus according to claim 1,**

**wherein, if the types of information to be exchanged contained in the exchange request information from the mutual exchanging parties match, the exchange determination unit determines that information exchange is permitted** (Paragraphs [0029] - [0030] of Sueki discloses that the mediation server chooses possible registrants based on the application information, which includes the object of the information exchange (read to be the same as type of information). This implies that the registrant's information will match the originating parties information. Thus it is seen that information exchange is only permitted if the type of information matches).

**As to claim 3, Sueki teaches the information exchange support apparatus according to claim 1,**

**wherein, if the types and the contents of information to be exchanged contained in the exchange request information from the mutual exchanging parties match, the exchange determination unit determines that information exchange is permitted** (Paragraphs [0029] - [0030] of Sueki discloses that the mediation server chooses possible registrants based on the application information, which as shown above includes the object of the information exchange (read to be the type of information) as well as the field or genre of the information exchange (read to be the content of information). This implies that the registrant's information will match the originating parties information. Thus it is seen that information exchange is only permitted if the requested type of information and requested content of the information match).

**As to claim 4, Sueki teaches the information exchange support apparatus according to claim 1,**

**wherein, if the types or the contents of information to be exchanged match a predetermined type or content of information to be exchanged, the exchange determination unit determines that information exchange is permitted** (Paragraphs [0029] - [0030] of Sueki discloses that the mediation server chooses possible registrants based on the application information, which as shown above includes the object of the information exchange (read to be the type of information) as well as the field or genre of the information exchange (read to be the content of information). This implies that the

registrant's information will match the originating parties information and also shows that since the application information is input first it can be considered predetermined information. Thus it is seen that information exchange is only permitted if the requested type of information and requested content of the information match predetermined information. Since Sueki covers the situation where both the type and content must match it would be obvious to also cover situations where the type or content must match).

**As to claim 5, Sueki teaches the information exchange support apparatus according to claim 1,**

**wherein the exchange request information contains information indicating the type of information to be exchanged requested for the exchanging party** (Paragraph [0029] of Sueki discloses that the application information to be input includes the object of the information exchange. This is read to be the same as indicating the type of information to be exchanged), and

**wherein, if the types of information to be exchanged contained in the exchange request information from the mutual exchanging parties match the requested type for the exchanging party, the exchange determination unit determines that information exchange is permitted** (Paragraph [0030] of Sueki discloses that the mediation server chooses possible registrants based on the application information, which as shown above includes the types of information. This implies that the registrant's

information will match the originating parties information. Thus it is seen that information exchange is only permitted if the requested type of information matches).

**As to claim 6, Sueki teaches the information exchange support apparatus according to claim 1,**

**wherein the exchange request information contains information indicating the type and the content of information to be exchanged requested for the exchanging party** (Paragraph [0029] of Sueki discloses that the application information to be input includes the object of the information exchange (read to be the type of information) as well as the field or genre of the information exchange (read to be the content of information)), **and**

**wherein, if the types and the contents of information to be exchanged contained in the exchange request information from the mutual exchanging parties match the requested type and content for the exchanging party, the exchange determination unit determines that information exchange is permitted** (Paragraph [0030] of Sueki discloses that the mediation server chooses possible registrants based on the application information, which as shown above includes the types of information and content of the information. This implies that the registrant's information will match the originating parties information. Thus it is seen that information exchange is only permitted if both the requested type of information and requested content of the information match).

**As to claim 7, Sueki teaches the information exchange support apparatus according to claim 1,**

**wherein the exchange request information contains content report information indicating the content of information to be exchanged contained in the exchange request information** (Paragraph [0029] of Sueki discloses that the application information to be input includes the field or genre of the information exchange (read to be the content of information)), and

**wherein, if the content report information matches the content of the received information to be exchanged, the exchange determination unit determines that information exchange is permitted** (Paragraph [0030] of Sueki discloses that the mediation server chooses possible registrants based on the application information, which as shown above includes the content of the information. This implies that the registrant's information will match the originating parties information. Thus it is seen that information exchange is only permitted if the requested content of the information matches).

**As to claim 10, Sueki teaches the information exchange support apparatus according to claim 1, further comprising:**

**a preliminary disclosure unit which preliminarily discloses the information to be exchanged for the exchanging party** (Paragraph [0031] of Sueki discloses that after a candidate has been chosen the selected candidate receives the application information to help make their decision),

**wherein, if consent information indicating exchange consent is received from the mutual exchanging parties after the preliminary disclosure unit preliminarily discloses the information to be exchanged, the exchange determination unit determines that information exchange is permitted** (Paragraph [0032] explains that the selected registrant delivers an answer to the mediation server and if the answer is affirmative the mediation server notifies the applicant and begins the exchange process).

**As to claim 15, Sueki teaches an information exchange support program for causing a computer to function as an information exchange support apparatus according to claim 1** (Examiner recites the rejection used in claim 1).

**As to claim 16, Sueki teaches an information exchange support method for supporting exchange of information through a network** (Paragraph [0010] of Sueki discloses an invention to provide an information mediation system which is capable of mediating exchange of information between an applicant and registrant), **the information exchange support apparatus comprising:**

**a reception step of receiving exchange request information containing information to be exchanged and information for identifying an exchanging party** (Paragraph [0012] of Sueki discloses receiving a request of information exchange from an applicant and then receiving from the applicant information of a selected registrant);

**an exchange determination step of determining whether or not information exchange is permitted using the received exchange request information** (Paragraph [0030] of Sueki discloses that the mediation server will choose possible registrants based on the application information. This is read to cover the functionality of the applicants invention because whether or not a registrant is eligible (permitted) to exchange information is determined by the application information (received exchange information)); and

**a transmission step of transmitting the information to be exchanged to the exchanging party if the exchange determination step determines that information exchange is permitted** (Paragraph [0012] of Sueki discloses transmitting at least a part of the retrieved information of at least one of the registrant to the applicant and then in paragraph [0031] the mediation server sends the application information to the selected registrant),

**wherein, if the exchange request information from the mutual exchanging parties is already received, the exchange determination steps determines that information**

**exchange is permitted** (Paragraphs [0031] - [0034] of Sueki disclose that after receiving the name of the selected candidate registrant from the applicant and after the registrant gives an affirmative response the mediation server notifies both parties to prepare for information exchange).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sueki as applied to claim 1 above and further in view of U.S. Pat. No. 5948054 to Nielsen (hereinafter "Nielsen").

**As to claim 8, Sueki teaches the information exchange support apparatus according to claim 1. Sueki does not teach but Nielsen teaches wherein the reception**

**unit receives the exchange request information using an electronic mail system or a Web page** (Column 1 lines 50 – 67 of Nielsen discloses a system where a customer with a question connects to a world wide web server which offers a matchmaking service (read to be a web page). The customer fills in a form that is later posted on personal web pages for consultants by the matchmaking service. This is read to be a system that receives information requests via a web page).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the exchange support apparatus of claim 1 taught by Sueki, with the usage of a web page for receiving requests taught by Nielsen.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine because Sueki already discloses (paragraph [0021] of Sueki) communicating via networks and then also discloses (paragraph [0028] of Sueki) using e-mail to transmit information to the registrants. Thus making the step to use a web page or e-mail system to receive information as taught by Nielsen would be an obvious next step.

"Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle... When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is

likely the product not of innovation but of ordinary skill and common sense." See KSR v. Teleflex, 550 U.S. \_\_\_, 127 S. Ct. 1727 (2007).

**As to claim 9, Sueki teaches the information exchange support apparatus according to claim 1.** Sueki does not teach but Nielsen teaches **wherein the transmission unit transmits the information to be exchanged using an electronic mail system or a Web page** (Column 2 lines 35 – 45 of Nielsen discloses that the server looks up the customer's email address and then forwards the answer to the customer. This is read to be using an electronic mail system to transmit information).

Examiner recites the same rationale to combine used in claim 8.

11. Claims 11, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sueki as applied to claim 10 above and further in view of U.S. Pub. No. 2004/0006543 to Twining et al. (hereinafter "Twining").

**As to claim 11, Sueki teaches the information exchange support apparatus according to claim 10.**

Sueki does not teach but Twining teaches **wherein the exchange request information contains preliminary disclosure and consent required/not required information indicating whether or not exchange consent is required, of information to be**

**exchanged of the exchanging party** (Paragraph [0012] of Twining discloses that one or more restricted descriptions of the proposed transaction and one or more conditions of release for each of the restricted descriptions are received from the originating party.

This is read to be the same because containing one or more conditions of release is seen to be the same having consent required/not required information), **and**

**wherein, if the consent required/not required information indicates [not] required, the preliminary disclosure unit preliminarily discloses the information to be exchanged for the exchanging party** (Paragraph [0012] of Twining discloses that the first thing sent is an unrestricted description of the proposed transaction from the originating party. This is read to be the same as the situation in which consent is not required because it is unrestricted information, and because it is unrestricted it is preliminarily disclosed).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the exchange apparatus according to claim 10 as taught by Sueki, with restricting some of the information to be exchanged as taught by Twining.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine these because Twining teaches (paragraph [0037] of Twining) that the above system would protect both the originating party and the potential buying party to the extent required by the parties.

**As to claim 12, Sueki teaches the information exchange support apparatus according to claim 10.** Sueki does not teach but Twining teaches **wherein the preliminary disclosure unit discloses the information to be exchanged in a mode in which the exchanging party cannot save all information to be exchanged** (Abstract and paragraphs [0036] – [0037] of Twining disclose a system where an originating party and a potential buying party can perform a transaction that uses various levels of unrestricted and restricted descriptions of the proposed transaction. Where the having various levels of unrestricted and restricted descriptions is read to be the same as not being able to save all of the information to be exchanged).

Examiner recites the same rationale to combine used in claim 11.

**As to claim 14, Sueki teaches the information exchange support apparatus according to claim 1.**

Sueki does not teach but Twining teaches **wherein, when information exchange is executed at least among three parties, if the exchange request information of all parities are all already received, the exchange determination unit determines that information exchange is permitted** (Paragraph [0003] and [0010] of Twining discloses a method for facilitating a transaction between two or more parties (read to cover the situation of at least three). Registration information is received from each party to the

transaction and a secured account is assigned for the transaction (read to cover the exchange request information sent by all parties)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the exchange apparatus according to claim 1 as taught by Sueki, with extending the system to work with more than two parties as taught by Twining. One of ordinary skill in the art at the time the invention was made would have been motivated to combine because Twining explains that (paragraph [0003] of Twining) the current system for negotiations process for agreements is cumbersome and time consuming. Thus because Twining's method allows all parties to participate simultaneously time would be saved.

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sueki and Twining as applied to claim 12 above and further in view of Nielsen.

**As to claim 13, Sueki and Twining teaches the information exchange support apparatus according to claim 12. Sueki and Twining do not teach but Nielsen teaches wherein the preliminary disclosure unit discloses the information to be exchanged using an electronic mail system or a Web page (Column 2 lines 35 – 45 of Nielsen discloses that the server looks up the customer's email address and then forwards the answer to the customer. This is read to be using an electronic mail system to transmit information, which is the same as disclosing the information to the exchanging party).**

Examiner recites the same rationale to combine used in claim 8.

***Conclusion***

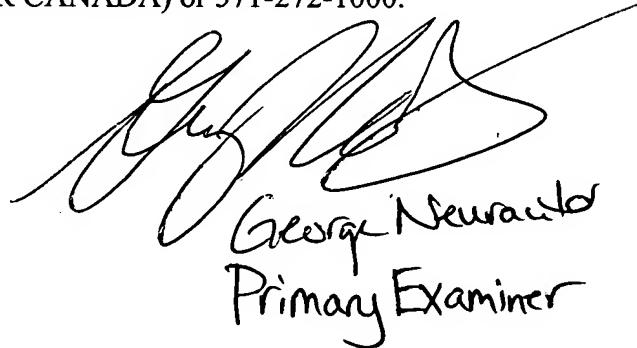
Prior art(s) made of record but not relied upon:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin S. Mai whose telephone number is 571-270-5001. The examiner can normally be reached on Monday through Friday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Taghi Arani can be reached on 571-272-3787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KSM



George Newland  
Primary Examiner